THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAWRENCE E. MIGGINS

Appeal No. 1999-1978
Application No. 08/864,442[1]

ON BRIEF

Before CALVERT, ABRAMS, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 5 and 8 through 11, which are all of the claims pending in this application.

We REVERSE.

[1] Application for patent filed May 28, 1997. According to the appellant, the application is a continuation of Application No. 08/656,087, filed May 31, 1996, now abandoned.

BACKGROUND

The appellant's invention relates to a weighted practice bat. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hamilton	3,521,883	July 28, 1970
Worst	4,331,330	May 25, 1982
Dirksing et al.	4,819,935	Apr. 11, 1989

Claims 1, 5 and 9 through 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hamilton in view of Worst.

Claims 3 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hamilton in view of Worst as applied to claim 1 above, and further in view of Dirksing.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 21, mailed December 21, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 20, filed October 27, 1998) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 3, 5 and 8 through 11 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require a weighted ring "permanently secured" to/on the barrel of a bat. It is our view that the applied prior art does not teach or suggest a weighted ring "permanently secured" to/on the barrel of a bat. In that regard, Hamilton teaches a weighted ring 10 removably clamped in various ways to the barrel of a bat 9. In fact, Hamilton teaches (column 1, lines 23-64) that the bat may be a

regulation baseball bat, the bat is weighted with a removable weight, and that an object of his invention is to provide a means for non-destructively weighting a regulation baseball bat. Thus, it is our view that Hamilton does not teach or suggest "permanently securing" the weighted ring 10 to the bat 9 in the manner recited in the claims under appeal. We have also reviewed the references to Worst and Dirksing but find nothing therein which makes up for the deficiency of Hamilton discussed above.

Since all the limitations of the claims under appeal are not taught or suggested by the applied prior art for the reason stated above, the decision of the examiner to reject claims 1, 3, 5 and 8 through 11 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3, 5 and 8 through 11 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT Administrative Patent Judge	)
NEAL E. ABRAMS Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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APPEAL NO. 1999-1978 - JUDGE NASE
APPLICATION NO. 08/864,442

APJ NASE

APJ CALVERT

APJ ABRAMS

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 12 Aug 99

FINAL TYPED:

Gloria: Change panel order